

REMARKS

With this Response, no claims are amended, added, or cancelled. Therefore, claims 1-29 are pending.

DOUBLE PATENTING

Claims 1, 2, 7, 9, 16, 21, 22, 24, 25 and 27 and the intervening claims, were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 3-5, 9-13, 16, 19, 21-24, 26, 30 and 33 of prior US Patent No. 6,922,717 of Ruehle (hereinafter "Ruehle"). Applicants respectfully submit that this rejection is improper. Applicants refer to MPEP § 804.II.A, which recites:

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a **claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine."** On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

Applicants further refer to the Specification at page 11 [0030] to [0031], which describes a modular exponentiator, which includes at least a modular multiplier. Applicants note that a modular exponentiator and a modular multiplier are not equivalent. Seeing that a modular exponentiator as described includes a modular multiplier, the present application is distinct from the above-referenced US patent, using similar logic as that presented in the MPEP section reproduced above.

Based on this double-patenting rejection and the obviousness rejection below (which will be discussed below), Applicants suspect that the Office Action is interpreting a modular exponentiator and a modular multiplier to be the same thing, which is erroneous.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 1-29 were rejected under 35 U.S.C. § 103 as being unpatentable over US Patent No. 6,240,436 to McGregor (hereinafter "McGregor") in view of US Patent No. 5,189,636 to Patti et al. (hereinafter "Patti"). Applicants submit that these claims are not rendered obvious by the cited references for at least the following reasons.

As mentioned above, it appears that the rejection is based on an improper interpretation in the Office Action, which would equate a modular exponentiator to a modular multiplier. Claim 1 recites "a plurality of modular exponentiators," which is also recited in the remaining independent claims 9, 16, 21, 24, and 27. The McGregor reference at most discloses a single exponentiator (which has multiple multiplier units 28a and 28b). See col. 4, lines 24 to 38. Thus, the assertion in the Office Action at page 3 (that multiplier units 28a and 28b disclose multiple exponentiators) is not supported in the reference.

Furthermore, Applicants note that the Patti reference discusses the combination of multiple adders by a selectable AND gate to combine multiple adders into a single adder. The Office Action asserts based on this discussion that Patti discloses combining multiple exponentiators together. Applicants do not concede that one of ordinary skill in the art would understand the reference to disclose what is asserted in the Office Action. Applicants further do not concede that the references are properly combinable. Without having to further discuss the reference, Applicants submit that Patti is not cited for curing the deficiency of McGregor mentioned above, nor does it cure the deficiency. Thus, whether or not the reference discloses what is asserted in the Office Action, which Applicants do not concede, Patti fails to cure the deficiencies of McGregor. Whether alone or in combination, the references fail to disclose or suggest at least one limitation of the claimed invention, and so fail to support an obviousness rejection under MPEP § 2143.

Regarding the dependent claims, Applicants note that claims depending from a nonobvious independent claim are also nonobvious. See MPEP § 2143.03. Thus, the dependent claims are patentable over the cited references for at least the reasons set forth above with respect to the independent claims.

CONCLUSION

For at least the foregoing reasons, Applicant submits that the rejections of the claims have been overcome herein, placing all pending claims in condition for allowance. Such action

is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
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Theresa Belland 01/10/06
 Date